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PATENT
P55248

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

In re Application of:

Appeal No. _____

KWANG-YOUN PARK *et al.*

Serial No.: 09/100,952

Examiner: CHIEU, P.

Filed: 22 June 1998

Art Unit: 2615

For: METHOD AND APPARATUS FOR RESERVE-RECORDING A VIEWING
BROADCAST PROGRAM

Attn: Board of Patent Appeals & Interferences

APPEAL BRIEF

Commissioner for Patents
Washington, D.C. 20231

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Sir:

Pursuant to Appellant's Notice of Appeal filed on 12 June 2002, Appellant hereby appeals to the Board of Patent Appeals and Interferences from the final rejection of claims 1 thru 12, as set forth in the final Office action mailed on 12 February 2002 (Paper No. 9), and the Advisory Action mailed on 22 May 2002 (Paper No. 11).

Folio: P55248
Date: 7/25/02
I.D.: REB/JGS/kf

I. REAL PARTY IN INTEREST

Pursuant to 37 CFR §1.192(c)(1)(as amended), the real party in interest is:

SamSung Electronics Co., Ltd.
#416, Maetan-dong, Paldal-gu
Suwon-city, Kyungki-do, Republic of KOREA

as evidenced by the Assignment executed by the inventor on 21 August 1998 and recorded in the U.S. Patent & Trademark Office on 9 September 1998 at Reel 9943, frame 0646.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals and no interferences known to Appellant, Appellant's legal representatives or the assignee which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1 thru 12 stand finally rejected. Of the latter claims, claims 1, 5 and 9 are independent, whereas the remaining claims are dependent.

IV. STATUS OF AMENDMENTS

No Amendment was filed subsequent to the final Office action mailed on 12 February 2002 (Paper No. 9).

V. SUMMARY OF INVENTION

The present invention relates to a method and apparatus for reserve-recording a broadcast program and, more particularly, to a method and apparatus for reserve-recording a currently viewed broadcast program so that, while a user views the broadcast program, a subsequent broadcast portion of the broadcast program is reserve-recorded as a result of a single key input by the user.

As described in the specification with reference to Figure 2, the method of the present invention provides the capability of reserve-recording a broadcast program during viewing by a user, and comprises the steps of (a) pre-storing program identification information contained in broadcast signals of broadcast stations (*see* paragraph [0016] of the substitute specification), (b) selecting a given broadcast program for reserve-recording during viewing of the given broadcast program (*see* paragraph [0017] of the substitute specification and block 201), (c) maintaining the viewing of the given broadcast program selected at step (b) without interruption while reading program identification information corresponding to the selected given broadcast program from the program identification information previously pre-stored (*see* paragraph [0017] of the substitute specification and block 202), and (d) setting reserve-recording data using the program identification information read in the preceding step (*see* paragraph [0017] of the substitute specification and block 203).

The reserve-recording apparatus of the present invention comprises, with reference to Figure 1: a first storage unit 13 for pre-storing program identification information contained in a broadcast signal of at least one broadcast station; a key input unit 11 for applying a key input signal for reserve-

recording a given broadcast program being viewed by a user; a controller 12 for maintaining viewing of the given broadcast program when receiving the key input signal from the key input unit 11, for reading the program identification information corresponding to the given broadcast program from the first storage unit 13, and for setting reserve-recording information in accordance with the read program identification information; and a second storage unit 14 for storing the reserve-recording information set by the controller 12.

In accordance with the invention, with reference to the specification and Figures 1 and 2, the method of reserve-recording a given broadcast program also comprises the steps of: receiving a broadcast signal from a broadcast station via an antenna, and extracting program identification information contained in the broadcast signal from said broadcast station (*see* paragraph [0016] of the substitute specification); storing the program identification information contained in the broadcast signal from said broadcast station in a first memory 13 (*see* paragraph [0016] of the substitute specification); determining whether a reserve key signal is input by a user for reserve-recording while the user is viewing the given broadcast program (*see* paragraph [0017] of the substitute specification and block 201); when the reserve key signal is input by the user during viewing of the given broadcast program, recognizing the given broadcast program being viewed as a broadcast program to be reserve-recorded, and maintaining the viewing of the given broadcast program without interruption (*see* paragraph [0017] of the substitute specification); and reading the program identification information corresponding to the given broadcast program from the first memory 13, setting reserve-recording information in accordance with the read program identification

information, and storing the reserve-recording information in a second memory 14 for reserve-recording (*see* paragraph [0017] of the substitute specification and block 203).

The program identification information contains broadcast titles, broadcast date, time and channel data relating to the given broadcast program, and the reserve-recording data includes channel data, recording date and time which are the same as those contained in the program identification information corresponding to the given broadcast program being viewed.

VI. ISSUE

The issue is whether claims 1 thru 12 were properly rejected under 35 U.S.C. §103(a) for alleged unpatentability over Young *et al.*, U.S. Patent No. 5,479,266 in view of Lawler *et al.*, U.S. Patent No. 5,699,107 and Yuen *et al.*, U.S. Patent No. 6,154,203.

VII. GROUPING OF THE CLAIMS

The claims do not stand or fall together, and thus the claims are grouped as follows:

- claims 1 and 4;
- claims 2 and 3;
- claims 5 and 8;
- claims 6 and 7;
- claims 9 and 12; and
- claims 10 and 11.

VIII. ARGUMENT

Prior to presenting arguments in opposition to the final rejection, the grouping of the claims will be discussed.

Grouping of the Claims

Claims 1 and 4 are grouped together because the prior art does not disclose or suggest a method for reserve-recording a broadcast program during viewing by a user, comprising the pre-storing of program identification information, the selecting of a given program for reserve-recording during viewing of that program, the reading of the program identification information while maintaining viewing of the program without interruption, and the setting of reserve-recording data using the program identification information previously read.

Claims 2 and 3 are grouped together because the prior art does not disclose or suggest a method for reserve-recording a broadcast program during viewing by a user as recited in claim 1, wherein the program identification information contains broadcast titles, broadcast date, time and channel data relating to the selected given broadcast program, and the reserve-recording data includes channel data, recording date and time, which are the same as those contained in the program identification information corresponding to the selected given broadcast program.

Claims 5 and 8 are grouped together because the prior art does not disclose or suggest a reserve-recording apparatus having a first storage unit, a key input, a controller and a second storage unit with the functions recited in claim 5.

Claims 6 and 7 are grouped together because the prior art does not disclose or suggest the reserve-recording apparatus as recited in claim 5, wherein the program identification information contains broadcast titles, broadcast date, time and channel data relating to the selected given broadcast program, and the reserve-recording data includes channel data, recording date and time which are the same as those contained in the program identification information corresponding to the selected given broadcast program.

Claims 9 and 12 are grouped together because the prior art does not disclose or suggest a method of reserve-recording a given program, comprising: extracting program identification information contained in a received broadcast signal; storing the program identification information in a first memory; determining whether a reserve key signal is input by a user for reserve-recording while the user is viewing the given program when the reserve key signal is input by the user during viewing of the given broadcast program; recognizing the given broadcast program being viewed as a broadcast program to be reserve-recorded, and maintaining the viewing of the given broadcast program without interruption when the reserve key signal is input by the user; and reading the program identification information corresponding to the given broadcast program from the first memory, setting reserve-recording information in accordance with the read program identification information, and storing the reserve-recording information in a second memory for reserve-recording.

Claims 10 and 11 are grouped together because the prior art does not disclose or suggest a

method for reserve-recording a broadcast program during viewing by a user as recited in claim 9, wherein the program identification information contains broadcast titles, broadcast date, time and channel data relating to the selected given broadcast program, and the reserve-recording data includes channel data, recording date and time, which are the same as those contained in the program identification information corresponding to the selected given broadcast program.

Patentability Over Prior Art

For the reasons stated below, Appellant submits that claims of this application recite the invention in sufficient detail to be patentable over the prior art cited in the final Office action.

In paragraph 3 on page 3 of the final Office action, the Examiner rejected claims 1 thru 12 under 35 U.S.C. §103 for alleged unpatentability over Young *et al.*, U.S. Patent No. 5,479,266 in view of Lawler *et al.*, U.S. Patent No. 5,699,107 and Yuen *et al.*, U.S. Patent No. 6,154,203. For the reasons stated below, it is submitted that the invention recited in the claims is distinguishable from the prior art cited by the Examiner so as to preclude rejection under 35 U.S.C. §103.

Young *et al.* '266 discloses a user interface for a television schedule system. Young *et al.* '266 does not state how the schedule information for the television schedule system is obtained. Thus, Young *et al.* '266 does not appear to disclose the pre-storage of program identification information which, as claimed, is contained in broadcast signals of broadcast stations.

Young *et al.* '266 also does not disclose selecting a given broadcast program **for reserve-recording** in combination with maintaining the viewing of the given broadcast program **selected for recording** without interruption while reading the program identification information.

In the Examiner's comments accompanying the Advisory Action of 22 May 2002 (Paper No. 11), the Examiner selectively addresses only some of the issues raised in the Response After Final filed on 10 May 2002. With respect to the preceding paragraph, the Examiner neglects to address the inability of Young '266, as modified in the Examiner's proposed combination, to select a given broadcast program *for reserve recording* in combination with maintenance of the viewing of the given broadcast program *selected for recording* without interruption while reading the program identification information, as defined by the pending claims. The Examiner ignores the latter distinction.

On page 2 of the Advisory Action (Paper No. 11), the Examiner attempts to argue that program guide information is equivalent to program identification. However, program guide information is a **prospective** prediction of broadcast, while the claimed program identification is a **contemporary** identification of the broadcast. They are not equivalent.

On page 2 of the final Office action, the Examiner admits that Young *et al.* '266 does not disclose that the viewing of a currently reviewed program is maintained while program identification information corresponding to a selected broadcast program is read from pre-stored program

identification information. However, the Examiner cites Yuen *et al.* '203 as allegedly disclosing, in Fig. 2 thereof, maintenance of the viewing of a broadcast program.

A review of Yuen *et al.* '203, and Fig. 2 in particular, discloses that a "picture in a picture" arrangement is provided so that a video broadcast program 42 is reduced substantially in size, and displayed in the upper left hand portion of a display screen, while broadcast information is displayed in the lower half of the screen, and specifically selected broadcast information is displayed in an upper right hand portion of the screen. However, the viewing of the program and simultaneous viewing of the broadcast information is not carried out with respect to a program selected for reserve-recording as claimed herein. In fact, Young *et al.* '266 describes this feature as the use of "a picture-in-picture (PIP) setup to allow the user to view an active television channel while browsing the channel guide" (emphasis supplied -- Abstract, lines 2-3). Thus, the user is not necessarily viewing broadcast information corresponding to the broadcast being viewed, as claimed herein.

In addition, the broadcast being viewed in Young *et al.* '266 is not a program which has been selected for reserve-recording, as claimed. In Young *et al.* '266, the broadcast being viewed is merely a broadcast selected for viewing only.

Further, it cannot be said that Yuen *et al.* '203 discloses the maintenance of the viewing of a given program without interruption while program identification information corresponding to

identification information. However, the Examiner cites Yuen *et al.* '203 as allegedly disclosing, in Fig. 2 thereof, maintenance of the viewing of a broadcast program.

A review of Yuen *et al.* '203, and Fig. 2 in particular, discloses that a “picture in a picture” arrangement is provided so that a video broadcast program 42 is reduced substantially in size, and displayed in the upper left hand portion of a display screen, while broadcast information is displayed in the lower half of the screen, and specifically selected broadcast information is displayed in an upper right hand portion of the screen. However, the viewing of the program and simultaneous viewing of the broadcast information is not carried out with respect to a program **selected for reserve-recording** as claimed herein. In fact, ~~Young *et al.* '266~~ Yuen *et al.* '203 describes this feature as the use of “a picture-in-picture (PIP) setup to allow the user to view an active television channel while **browsing** the channel guide” (emphasis supplied -- Abstract, lines 2-3). Thus, the user is not necessarily viewing broadcast information corresponding to the broadcast being viewed, as claimed herein.

In addition, the broadcast being viewed in ~~Young *et al.* '266~~ Yuen *et al.* '203 is not a program which has been selected for reserve-recording, as claimed. In ~~Young *et al.* '266~~ Yuen *et al.* '203, the broadcast being viewed is merely a broadcast selected for viewing only.

Further, it cannot be said that Yuen *et al.* '203 discloses the maintenance of the viewing of a given program **without interruption** while program identification information corresponding to

a selected broadcast program is being read. That is to say, in Yuen *et al.* '203, the viewing is subjected to a substantial and even severe reduction (by 75% or more) in the size of the broadcast picture. Thus, even if the combination of Young *et al.* '266 and Yuen *et al.* '203 is a proper combination under 35 U.S.C. §103, the combination of the two disclosures does not result in the present invention, as now claimed.

In paragraph 1 of the final Office action, the Examiner states that, in Yuen *et al.* '203, “[a]lthough the video is reduced[,] the video is not interrupted” (quoting from page 2, lines 4-5 of the final Office action). It is submitted that a substantial reduction in the size of the viewed broadcast does constitute an “interruption” of the viewing of the program, that is, an interruption of “viewing”, in the normal sense of the word, of the program.

In the latter regard, the Examiner ignores the fact that his proposed combination based upon Young '266 is unable to provide viewing of a selected program and simultaneous viewing of the broadcast information. The Examiner argues that the secondary reference of Lawler '107 discloses that a user is able to set reserve recording without interrupting the viewing of the selected program. This is not the same as the claimed selection of a given broadcast program *for reserve recording* while preserving the viewing of the given broadcast program *selected for recording* without interruption.

In addition, Appellant respectfully submits that there is nothing within the “four corners” of

the disclosure of Young *et al.* '266 which would prompt a person of ordinary skill in the art, upon reviewing the disclosure of that primary reference, to seek and incorporate the teachings of Yuen *et al.* '203. It is further submitted that the only reason the Examiner has been able to combine these two references is on the basis of hindsight, as assisted by the teachings presented in the present application. Thus, there is also a serious question as to the propriety of the combination of these two references under 35 U.S.C. §103.

On page 2 of the final Office action, the Examiner also admits that Young *et al.* '266 does not disclose selection of reserve-recording with respect to a current broadcast program. Therefore, the Examiner cites Lawler *et al.* '107 as allegedly disclosing the selection of a current broadcast program for reserve-recording. Applicant respectfully disagrees with this interpretation of Lawler *et al.* '107.

Specifically, Lawler *et al.* '107 discloses a program reminder system which is provided for the purpose of reminding a user of an interactive viewing system that a preselected program is available at a particular point of time. That is to say, the program reminder system of Lawler *et al.* '107 functions in such a manner that, upon arrival of the time at which a particular program is available, the reminder panel of the interactive viewing system identifies the selected program, informs the user that will be available shortly, and thus reminds the user to turn to the appropriate channel of the interactive viewing system for viewing (**not recording**) the selected program (*see the Abstract, last four lines*). Thus, even if the combination of Young *et al.* '266 and Yuen *et al.* '203

constitutes a proper combination under 35 U.S.C. §103, the result of combining these two references does not result in the invention, as claimed. That is to say, the arrangement resulting from the combination of these two references does not have the capability of selecting a broadcast program currently being viewed, and of setting **reserve-recording** with respect to the broadcast program currently being viewed.

In paragraph 1 of the final Office action, the Examiner points out the following: “Although Lawler *et al.* does offer a reminder feature (figure 8), the previous office action reference figure 10” (quoting from page 2, lines 17-18 of the final Office action). Apparently, the Examiner is citing Fig. 10 of Lawler *et al.* '107 for the disclosure of a “Record This Show” capability, referring to a program currently being viewed. This constitutes a disclosure of what appears to be an “instant record” or “quick timer” feature, which is not relevant to the claimed invention. That is, the claimed invention pertains to a method and system which perform, in sequence, respective steps and functions of pre-storing program identification information, selecting a given broadcast program for reserve-recording during viewing thereof, maintaining the viewing of the program while reading the program identification information, and setting reserve-recording data using the program identification information. A recording step, such as is disclosed in Yuen *et al.* '203, is not a part of the inventive method or system.

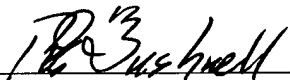
In addition, as was the case with respect to the combination of Young *et al.* '266 and Lawler *et al.* '107, there is nothing within the “four corners” of the disclosure of Young *et al.* '266 which

would motivate a person of ordinary skill in the art, upon reviewing that disclosure, to seek and incorporate the teachings of Yuen *et al.* '203. It is submitted that the only reason that the Examiner has been able to combine these two references is based on hindsight, as assisted by the teachings of the present application alone.

IX. CONCLUSION

In view of the law and facts stated herein, as well as all of the foregoing reasons, Appellant believes that the rejection is improper, and respectfully requests that the Board refuse to sustain the outstanding rejection of claims 1 thru 12 under 35 U.S.C. §103.

Respectfully submitted,



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Folio: P55248
Date: July 25, 2002
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X. APPENDIX

CLAIMS UNDER APPEAL (1-12)

1 1. (Amended) A method for reserve-recording a broadcast program during viewing by a user,
2 comprising the steps of:

3 (a) pre-storing program identification information contained in broadcast signals of
4 broadcast stations;

5 (b) selecting a given broadcast program for reserve-recording during viewing of the given
6 broadcast program;

7 (c) maintaining the viewing of the given broadcast program selected at step (b) without
8 interruption while reading program identification information corresponding to the selected given
9 broadcast program from the program identification information pre-stored at step (a); and

10 (d) setting reserve-recording data using the program identification information read at
11 step (c).

1 2. (Amended) The method of claim 1, said program identification information containing
2 broadcast titles, broadcast date, time, and channel data relating to the selected given broadcast
3 program, and said reserve-recording data including channel data, recording date and time which are
4 the same as those contained in the program identification information corresponding to the selected
5 given broadcast program.

1 3. (Amended) The method of claim 2, wherein said steps (a) thru (d) are executed by one of
2 a video cassette recorder and a television incorporated with a video cassette recorder.

1 4. (Amended) The method of claim 1, wherein said step (a) thru (d) are executed by one of
2 a video cassette recorder and a television incorporated with a video cassette recorder.

1 5. (Amended) A reserve-recording apparatus, comprising:
2 a first storage unit for pre-storing program identification information contained in a broadcast
3 signal of at least one broadcast station;
4 a key input unit for applying a key input signal for reserve-recording a given broadcast
5 program being viewed by a user;
6 a controller for maintaining viewing of the given broadcast program when receiving the key
7 input signal from the key input unit, for reading the program identification information
8 corresponding to the given broadcast program from the first storage unit, and for setting reserve-
9 recording information in accordance with the read program identification information; and
10 a second storage unit for storing the reserve-recording information set by the controller.

1 6. (Amended) The reserve-recording apparatus of claim 5, wherein said controller reads
2 channel data, broadcast date and time contained in the program identification information
3 corresponding to the given broadcast program from the program identification information stored
4 in the first storage unit.

1 7. (Amended) The reserve-recording apparatus of claim 6, said apparatus being embodied
2 in one of a video cassette recorder and a television incorporated with a video cassette recorder.

1 8. (Amended) The reserve-recording apparatus of claim 5, said apparatus being embodied
2 in one of a video cassette recorder and a television incorporated with a video cassette recorder.

1 9. (Amended) A method of reserve-recording a given broadcast program, comprising the
2 steps of:

3 receiving a broadcast signal from a broadcast station via an antenna, and extracting program
4 identification information contained in the broadcast signal from said broadcast station;

5 storing the program identification information contained in the broadcast signal from said
6 broadcast station in a first memory;

7 determining whether a reserve key signal is input by a user for reserve-recording while the
8 user is viewing the given broadcast program;

9 when the reserve key signal is input by the user during viewing of the given broadcast
10 program, recognizing the given broadcast program being viewed as a broadcast program to be
11 reserve-recorded, and maintaining the viewing of the given broadcast program without interruption;
12 and

13 reading the program identification information corresponding to the given broadcast program
14 from the first memory, setting reserve-recording information in accordance with the read program

15 identification information, and storing the reserve-recording information in a second memory for
16 reserve-recording.

1 10. (Amended) The method of claim 9, said program identification information containing
2 broadcast titles, broadcast date, time and channel data relating to the given broadcast program, and
3 said reserve-recording data including channel data, recording date and time which are the same as
4 those contained in the program identification information corresponding to the given broadcast
5 program being viewed.

1 11. (Amended) The method of claim 10, wherein said steps of said method are executed by
2 one of a video cassette recorder and a television incorporated with a video cassette recorder.

1 12. (Amended) The method of claim 9, wherein said steps of said method are executed by
2 one of a video cassette recorder and a television incorporated with a video cassette recorder.



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TRANSMITTAL OF APPELLANT'S BRIEF FEE

Assistant Commissioner
for Patents
Washington, D.C. 20231

Sir:

Accompanying this transmittal is a check drawn to the U.S. Department of Treasury in the amount of \$320.00 for the filing a Brief in support of a Notice of Appeal on 12 June 2002. Should any additional fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 in that amount. Please inform the Applicant of any transactions involving the Deposit Account.

Respectfully submitted,

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